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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER FELTEN, DANIEL S				
ART UNIT 3696		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/733,138

Applicant(s)

LUKOSE, RAJAN MATHEW

Examiner

DANIEL S. FELTEN

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-17, 20, 32 and 38-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-17, 20, 32 and 38-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II (claims 11-17, 20, 32 and 38-41) in the reply filed on May 05, 2008 is acknowledged. Thus claims 11-17, 20, 32 and 38-41 are provided to be presented for examination.

Response to Arguments

Applicant's arguments filed February 26, 2008 has been fully considered but they are not persuasive. In as far as the applicant has argued a lack of a prima facie case asserting that Walker does not teach an uncertain of an event occurring, it is again maintained references in determining obviousness are not read in isolation but for what they fairly teach in combination with the prior art as a whole, and thus patent assignee's reference-by-reference attack on prior art as a whole to demonstrate non-obviousness is not persuasive [In re Merck, 231 USPQ 375 (CAFC 1986)]. It is also submitted that references are evaluated by what they *suggest* to one versed in the art, rather than their specific disclosure [see In re Bozek, 163 USPQ 545 (CCPA 1969)]. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Both Walker and Johnson suggests at least one scenario where there is an

level of uncertainty wherein there is a purchase of airline tickets (see column 1, line 25+), thus the rejections are maintained.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore,

in claims 11 and 38, the relation module, offer module, receiving module, specification module, condition module, probability module, trigger module and a contingent payment module, whereby a system and modules have both software and hardware components (e.g., memory modules such as single in-line memory modules or SIMMs). It is not well understood/shown in the drawings what aspects (e.g., hardware and/or software) of the invention show these features.

in claims 12 and 39, a base payment processing *system*, whereby a system has both software and hardware components. It is not well understood from the drawings

in claims 13-15, a contingency payment processing *system*

in claim 20, the receiving *system*

The aforementioned feature(s) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-17, 20, 32 and 38-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claims 11 and 38, the relation module, offer module, receiving module, specification module, condition module, probability module, trigger module and a contingent payment module, whereby a system and modules have both software and hardware components (e.g., memory modules such as single in-line memory modules or SIMMs). It is not well understood/shown in the

specification what aspects (e.g., hardware and/or software) of the invention show these features. In claim 12, a base payment processing *system*, whereby a system has both software and hardware components. It is not well understood from the specification what hardware is provided in the system. In claims 13-15, a contingency payment processing *system*. In claim 20, the receiving *system*.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 11-17, 20, 32 and 38-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A module has The word "module" is indefinite

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11, 12, 16, 17, 20, 32 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 5,794,207) in view of Johnson (US 6,529,885)

Re claims 11 and 38: Walker discloses a system for selling information to a buying system comprising:

--an *interface* (200)(figs. 1 and 2) operatively coupled to a buying system (400) via a communication link (network interface-245 and/or modem-450) (see figs. 1 and 2, column 12, lines 3-7);

--a *memory* (storage device -250)(RAM-215)(ROM-220)(fig. 2) to store information in electronic form (see fig. 2)(see column 12, at least lines 3-7);

--a *processor* (205)(see fig. 2, column 12, at least lines 3-7), comprising:

---a *relation module* to relate the information to an event that has not yet occurred (see at least purchasing airline tickets, column 15, line 66 to column 16, line 11);

---an offer module to offer the information for online sale (see Walker, col. 16, lines 3-45, and col. 22, lines 1-37);

As previously addressed in a prior office action, Walker fails to disclose that the CPO transactions are based upon a contingency per se or that the offer includes at least one contingency that provides an uncertainty of an event related to the information occurring;

Johnson teaches the fact that many transactions involve "built-in" contingencies that must be met before goods or title will change hands or obligations released (see Johnson, column 3, lines 12+) as well as carrying out electronic transactions, including electronic payments via electronic drafts that are based upon a number of contingencies (see Johnson, Abstract, col. 16, line 59 to col. 17, line 35., and col. 18, line 20, to col. 19, line 8).

Since Walker's conditional purchase offer (CPO), similar to Johnson's electronic draft documents, orders the payment of money; drawn by one person or bank on another once bound by the seller (see Walker column 9, lines 31-51; and column 15, line 45 to column 16, line 45). It would have been obvious for an artisan of ordinary skill in the art at the time of the invention to substantially modify and/or substitute the CPO in Walker with the transaction features found in Johnson, because an artisan at the time the Walker's invention would have recognized the competitive nature of effectuating bilateral buyer-driven commerce and would have availed themselves of the latest technology infrastructure to address the complexities of multi buyer/seller transactions that, conventionally, are based upon various contingencies on the part of the buyer and/or seller as well as various time restrictions on the acceptance and performance of the transaction. Thus such a modification would have been an obvious expedient well within the ordinary skill the art.

Walker fails to disclose selling information or that the information includes a condition about the at least on contingency, that satisfaction of the at least one condition will resolve the uncertainty of the event occurring to satisfy at least one of the contingences and will trigger at least part of the payment of the buyer. However, since in this case the information itself is considered a “good: and the act of providing information considered a “service”, an artisan at the time of Walker would have been motivated to buy and sell information via the receiving a first payment for the good or service if the at least one condition for the CPO is satisfied after the good or service has been provided to the buyer (see Walker, col. 16, lines 3-45*, and col. 22, lines 1-37).

Re claim 12: further comprising a base payment processing system that receives a base payment as the payment when the information has been provided.

Re claim 16: further comprising a condition setting system which sets the condition to resolve the uncertainty to thereby satisfy the contingency in the received offer (see recitations for Walker in claim 11)

Re claim 17: a counteroffer system that sends a counteroffer to the buyer based on the offer, the counteroffer provides the condition set to resolve the uncertainty of satisfy the contingency to the buyer; and purchase decision system that determines if the counteroffer with the condition set is accepted by the buyer, wherein the information is only provided if the condition set is accepted (see recitations for Walker in claim 11)

Re claim 20: wherein the receiving system receives the offer and the source of the information provides the information electronically (see explanation to given to claim 11).

Re claim 32: Wherein the information from the seller in response to the offer is proved with out a payment from the buyer (see recitations for Walker in claim 11)

Re claim 39: the payment includes a base payment upon providing the information to the buying system (see recitations for Walker in claim 11)

Re claim 40: the amount of the payment is maximized when the predicted probability is equal to a true probability the condition occurring (see recitations for Walker in claim 11)

Re claim 41: the function incorporates risk aversion (see recitations for Walker in claim 11)

8. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 5,794,207) as modified by Johnson (US 6,529,885) as applied to claim 1 as discussed above, and in further view of Lundgren (US5,608,620). The teachings of Walker as modified by Johnson have been discussed

Re claim 13: Walker as modified by Johnson discloses adjusting an amount for the first payment based upon a conditional satisfaction of a contingency (see Johnson, col. 18, lines 20-55), Walker as modified by Johnson fails to disclose adjusting an amount for the first payment based on a probability that the condition for the contingency will occur.

Lundgren discloses adjusting an amount for the first payment based on a probability that the condition for the contingency will occur (see Lundgren, col. 21 , line 58 to col. 23, line 15, and col. 23, lines 45-55). In view of the teachings of Lundgren, it would have been obvious for an artisan of ordinary skill at the time of the invention to employ the teachings of Lundgren to the teachings of Walker as modified by Johnson because an artisan at the time of the invention

would seek to compensate sellers to the degree of which buyer satisfaction is obtained. Thus an artisan at the time of the invention of Walker as modified by Johnson would have motivated to employ the teachings of Lundgren for protection against being over charged for goods and services as well as providing a sense of fairness to all parties involve in the transaction. Thus such a feature would have been an obvious expedient to one of ordinary skill in the art.

Re claim 14: Walker as modified by Johnson discloses selecting the condition for the contingency, and determining the amount for the first payment based on a function which uses the condition for the contingency occurring, fails to disclose selecting an announced for the condition for the contingency, and determining the amount for the first payment based on a function which uses the announced probability for the condition for the contingency occurring. This is disclosed by Lundgren (see Lindgren, col. 21, line 58 to col. 23, line 15., and col. 23, lines 45-55).

It would have been obvious for an artisan of ordinary skill at the time of the invention to employ the teachings of Lundgren to the teachings of Walker as modified by Johnson because an artisan at the time of the invention would seek to pay sellers based upon the amount or degree to the which the conditions and contingencies within the transaction are satisfied. Thus an artisan at the time of the invention of Walker as modified by Johnson would have motivated to employ the teachings of Lundgren so as not to over pay for goods and services as well as providing the buyer a sense of protection involved in process of completing the transaction. Thus such a feature would have been an obvious expedient to one of ordinary skill in the art.

Re claim 15. Walker as modified by Johnson discloses wherein the amount of the first payment is maximized when the condition occurs but fails to disclose the amount of the first

payment is maximized when the announced probability for the condition occurring is substantially the same as a true probability for the condition occurring. This is disclosed by Lundgren (see Lundgren, col. 24, lines 3-54). It would have been obvious for an artisan of ordinary skill at the time of the invention to employ the teachings of Lundgren to the teachings of Walker as modified by Johnson because an artisan at the time of the invention would seek to pay sellers based upon the amount or degree to the which the conditions and contingencies within the transaction are satisfied. Thus an artisan at the time of the invention of Walker as modified by Johnson would have motivated to employ the teachings of Lundgren for protection against over paying for goods and services as well as providing the seller a sense of accomplishment involved in process of completing the transaction. Thus such a feature would have been an obvious expedient to one of ordinary skill in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL S. FELTEN whose telephone number is (571)272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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